

## **REMARKS**

### **I. Status of the Claims**

Claims 1-6 are currently pending and stand rejected in this application. Without prejudice or disclaimer, claims 1, 2, 5, and 6 have been amended herein. Support for the amendments can be found in the specification as filed, for example, at page 30, line 10 - page 32, line 6. No new matter has been added.

### **II. Double Patenting Rejection**

The Examiner provisionally rejects claims 1, 4 and 6 on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/512,584. See Office Action at 2. Claims 1, 4, and 6 are also provisionally rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-3 of copending Application No. 10/590,775. Applicants respectfully request that these rejections be held in abeyance until allowable subject matter is indicated in the present application. See M.P.E.P § 804(I)(B).

### **III. Rejections under 35 U.S.C. § 102(b)**

#### **A. U.S. Patent No. 5,462,683 to Kinoshita et al.**

The Examiner rejects claims 1-6 under 35 U.S.C. § 102(b) over U.S. Patent No. 5,462,683 to Kinoshita (Kinoshita I). See Office Action at 5.

Specifically, the Examiner asserts that Kinoshita I teaches “a grease composition containing 7.5% by weight of a lithium soap thickener, meeting the limitations of claims 1(a) and 3, 1.0% by weight of tributylphosphites, meeting claims 1(b) and 6 where the phosphorus compound has structure (1) and 3.0% by weight of

molybdenum dithiocarbamate, and organic molybdenum compound meeting the limitations of claim 2.” *Id.* The Examiner also alleges that Example 7 of Kinoshita I “discloses a grease where tricresylphosphate ... is present [and] Kinoshita [I] teaches that urea-based compounds, as in claim 4, are also preferred thickeners, and from column 2 line 57 through column 3 line 10 (including structure I), teaches that a urea based thickener meeting the limitations of claim 5 is preferable.” Office Action at page 6.

Applicants respectfully traverse, and assert that this rejection is now moot in view of the amendment of claim 1. For a reference to be anticipatory under 35 U.S.C. § 102, the reference must teach each and every element as set forth in the claim. See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987); M.P.E.P. § 2131. Moreover, the reference must show the identical invention in as much detail as in the claims. See *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); M.P.E.P. § 2131.

Applicants assert the position that boron nitride powders, as required in Kinoshita I, are not part of the claimed invention. Instead, the present invention claims a grease composition **consisting essentially of** a thickener and at least one type of compound selected from the group consisting of phosphorus compounds represented by general formulas (1) and (2) below and their metal salts or amine salts, based on the total weight of the composition and optionally, additives chosen from specific lists of additives, the lists **not** including boron nitride powders.

Furthermore, comparative examples 3 and 4 of Kinoshita I, which lack boron nitride powders, do not contain at least one compound selected from the group

consisting essentially of phosphorus compounds represented by general formulas (1) and (2), as recited in the presently claimed grease composition. Likewise, comparative example 6 of Kinoshita I, which lacks boron nitride powders, but does disclose 1% tributylphosphites in the composition, further discloses 2.0% by weight of polysulfides (column 31, lines 5-15), included as an extreme pressure agent (column 25, lines 63-67 - column 26, lines 1-20). However, the claimed invention does not recite the use of polysulfides. Furthermore, the claimed invention is not obvious in view of Kinoshita I, because there is no teaching in Kinoshita I to not use boron nitride powders to arrive at the presently claimed invention. Accordingly, for at least these reasons, the rejection should be withdrawn.

**B. U.S. Patent No. 5,516,439 to Takeuchi et al.**

The Examiner also rejects claims 1-3 under § 102(b) over U.S. Patent No. 5,516,439 to Takeuchi (Takeuchi). See Office Action at 6. Specifically, the Examiner asserts that "Takeuchi discloses a grease [composition] comprising a base oil, a lithium soap, an organic molybdenum compound, and a zinc dithiophosphate ..." *Id.* Thus, the Examiner concludes that the "grease [composition] of Takeuchi therefore meets the limitations of claims 1-3." *Id.*

Again, Applicants respectfully traverse and assert that this rejection is now moot in view of the amendment of claim 1. Specifically, the Applicants point out that the grease composition of the present application as claimed, does not include a metal salt selected from the group consisting of metal salts of oxidized waxes, metal salts of petroleum sulfonates and metal salts of alkyl aromatic sulfonates as required by Takeuchi. See, e.g., Takeuchi Abstract. Further, the claimed invention is not

obvious in view of Takeuchi, because there is no teaching in Takeuchi to not use a metal salt selected from the group consisting of metal salts of oxidized waxes, metal salts of petroleum sulfonates and metal salts of alkyl aromatic sulfonates to arrive at the presently claimed invention.

**C. U.S. Patent No. 5,569,643 to Kinoshita et al.**

The Examiner makes a note of record to the U.S. Patent No. 5,569,643 to Kinoshita (Kinoshita II). See Office Action at pages 6-7. Specifically, the Examiner asserts that Kinoshita II "discloses grease compositions similar to those discussed in the rejections set forth." *Id.* at page 7.

Applicants respectfully disagree and assert that this note of record is now moot in view of the amendment of claim 1. Applicants submit that Kinoshita II teaches boron nitride powders as required in its grease compositions. Boron nitride powders cannot be present in the grease composition of the present application as claimed.

Accordingly, for at least this reason, the note of record should be withdrawn.

Furthermore, the claimed invention is not obvious in view of Kinoshita II, because there is no teaching in Kinoshita II to not use boron nitride powders to arrive at the presently claimed invention.

#### IV. Conclusions

In view of the foregoing amendment and remarks, Applicants request reconsideration and reexamination of the application and the timely allowance of the pending claims.

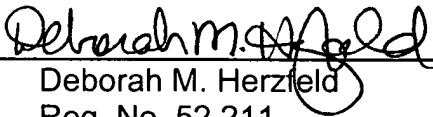
If the Examiner believes a telephone conference could be useful in resolving any of the outstanding issues, she is respectfully urged to contact Applicant's undersigned counsel at 202-408-4368.

If there is any fee due in connection with the filing of this Preliminary Amendment, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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By:   
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